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EDG 006-1292

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| TO: Mail Stop 8 Director of the U.S. Patent and Trademark Office P.O. Box 1450 | REPORT ON THE FILING OR DETERMINATION OF AN ACTION REGARDING A PATENT OR TRADEMARK |
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In Compliance with 35 U.S.C. § 290 and/or 15 U.S.C. § 1116 you are hereby advised that a court action has been filed in the U.S. District Court Central District of California on the following ☒ Patents or ☒ Trademarks:

| | | |
|---|-------------------------------|---|
| DOCKET NO. 1292 | DATE FILED NOV 17 2006 | U.S. DISTRICT COURT Central District of California |
| PLAINTIFF VAP (OPX) MAG INSTRUMENT, INC. | | DEFENDANT TERRALUX, INC. |

| PATENT OR TRADEMARK NO. | DATE OF PATENT OR TRADEMARK | HOLDER OF PATENT OR TRADEMARK |
|-------------------------|-----------------------------|-------------------------------|
| 1 RE 38,014 | 3/4/03 | Mag Instrument, Inc. |
| 2 D530,438 | 10/17/06 | Mag Instrument, Inc. |
| 3 D530,439 | 10/17/06 | Mag Instrument, Inc. |
| 4 2,074,795 | 7/1/97 | Mag Instrument, Inc. |
| 5 1,715,086 | 9/15/92 | Mag Instrument, Inc. |

In the above—entitled case, the following patent(s)/ trademark(s) have been included:

| DATE INCLUDED | INCLUDED BY |
|---------------|--|
| | <input type="checkbox"/> Amendment <input type="checkbox"/> Answer <input type="checkbox"/> Cross Bill <input type="checkbox"/> Other Pleading |

| PATENT OR TRADEMARK NO. | DATE OF PATENT OR TRADEMARK | HOLDER OF PATENT OR TRADEMARK |
|-------------------------|-----------------------------|-------------------------------|
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In the above—entitled case, the following decision has been rendered or judgement issued:

| |
|---|
| DECISION/JUDGMENT <i>Consent Judgment—see attached</i> |
|---|

| | | |
|----------------------------------|-------------------------------------|------------------------|
| CLERK <i>Sherri R. Carter</i> | (BY) DEPUTY CLERK <i>M. Mead</i> | DATE <i>4-17-08</i> |
|----------------------------------|-------------------------------------|------------------------|

Copy 1—Upon initiation of action, mail this copy to Director Copy 3— Upon termination of action, mail this copy to Director
 Copy 2—Upon filing document adding patent(s), mail this copy to Director Copy 4— Case file copy

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JS-6

6 Attorneys for Plaintiff
7 MAG INSTRUMENT, INC.

8
9 UNITED STATES DISTRICT COURT
10 CENTRAL DISTRICT OF CALIFORNIA

11
12 MAG INSTRUMENT, INC.,
13 Plaintiff,
14 v.
15 TERRALUX, INC.,
16 Defendant.

Case No. EDCV 06-1292 VAP (OPx)

**CONSENT JUDGMENT AND
PERMANENT INJUNCTION**

Hon. Virginia A. Phillips

1 WHEREAS plaintiff Mag Instrument, Inc. ("Mag Instrument") and defendant
2 TerraLUX, Inc. ("TerraLUX") have agreed in a separate agreement to settlement of
3 the matters in issue between them and to entry of this Consent Judgment and
4 Permanent Injunction, it is hereby ORDERED, ADJUDGED, AND DECREED
5 THAT:

6 1. This is an action for: (1) patent infringement under the patent laws of
7 the United States, 35 U.S.C. §271, *et seq.*; (2) federal trademark infringement,
8 federal false designation of origin, and federal trademark dilution under the
9 Trademark Act of 1946, as amended, 15 U.S.C. §1051, *et seq.*; (3) statutory unfair
10 competition under California Business and Professions Code §17200, *et seq.*; (4)
11 trademark dilution under California Business and Professions Code §14330; (5)
12 unauthorized infringement of a trademark under California Civil Code §3294; (6)
13 common law trademark infringement; and (7) common law unfair competition.

14 2. This Court has jurisdiction over all of the parties in this action and
15 over the subject matter in issue based on 28 U.S.C. §§1331, 1338, and 1367(a), as
16 well as 15 U.S.C. §1121. This Court further has continuing jurisdiction to enforce
17 the terms and provisions of this Consent Judgment and Permanent Injunction.
18 Venue is also proper in this Court pursuant to 28 U.S.C. §§1391(b) and (c) and
19 1400(b).

20 3. Plaintiff Mag Instrument is a corporation incorporated under the laws
21 of the State of California and has its principal place of business at 2001 South
22 Hellman Avenue, Ontario, California 91761.

23 4. Defendant TerraLUX is a corporation incorporated under the laws of
24 the State of Colorado and has its principal place of business at 1501 Lee Hill Road,
25 Unit 4, Boulder, Colorado 80304.

26 5. TerraLUX has manufactured, used, imported, offered for sale, and/or
27 sold certain Pocket LED Flashlights with TerraLUX Light Engines (Model
28 "Minimax" TCL MM-1AA) (the "Minimax Flashlights"), as shown in Exhibit 1.

1 The Minimax Flashlights were neither manufactured nor authorized by plaintiff
2 Mag Instrument.

3 6. TerraLUX has also manufactured, used, imported, offered for sale,
4 and/or sold certain Tail Cap Switches for AA MiniMag (TCL TCS-1) (the "Tail
5 Cap Switches"), as shown in **Exhibit 2**. The Tail Cap Switches were neither
6 manufactured nor authorized by plaintiff Mag Instrument.

7 7. TerraLUX has also manufactured, used, marketed, distributed,
8 advertised, promoted, imported, offered for sale, and/or sold the Microstar 1™
9 Conversion Kit for "MiniMag" AAA and AA Flashlights (TCL-TLE-10), the
10 MaxStar 2 for Maglite D (TCL-TLE-6N), the MiniStar 1 395 nm UV-A LEDs for
11 AA Mini Maglite (TLE-4UV), the LED Replacement MaxStar for 3 Cell C & D
12 Mag Instruments Flashlights (TCL DB-3W), the MiniStar 2 Kit (TLE-5), and the
13 MaxCharger3 (TLE-100), which are shown in **Exhibits 3-8** (collectively, along
14 with the Minimax Flashlight and the Tail Cap Switches, "the TerraLUX Products").
15 The above products were neither manufactured nor authorized by plaintiff Mag
16 Instrument.

17 8. Plaintiff Mag Instrument is, by assignment, the owner of all right, title,
18 and interest in United States Patent No. RE 38,014 ("the '014 patent"), United
19 States Patent No. D 530,438 ("the '438 patent"), and United States Patent No. D
20 530,439 ("the '439 patent"). Copies of these patents are attached hereto as
21 **Exhibits 9-11**, respectively.

22 9. The '438 patent and the '439 patent, both issued on October 17, 2006,
23 are valid and enforceable patents unless found invalid or unenforceable by a court
24 of competent jurisdiction without any right of appeal.

25 10. For many years, and prior to the acts of defendant TerraLUX discussed
26 herein, plaintiff Mag Instrument has continuously manufactured, advertised,
27 assembled, marketed, sold, and distributed, in interstate commerce, a line of
28 flashlights, including, but not limited to, a line of flashlights under the trademark

1 MINI MAGLITE®. These flashlights are also characterized by their shape, style,
2 and overall appearance ("SSOA").

3 11. The SSOA of the MINI MAGLITE® flashlight is non-functional and
4 has acquired secondary meaning in that it has come to be associated by the trade
5 and consuming public exclusively with plaintiff Mag Instrument and, as a result,
6 has come to signify plaintiff Mag Instrument as the source of flashlights bearing the
7 same or similar characteristics.

8 12. Plaintiff Mag Instrument has obtained, and is the owner of, a federal
9 registration on the SSOA of the MINI MAGLITE® flashlight (the "SSOA
10 Trademark"), which is valid and enforceable throughout the United States. A copy
11 of the SSOA Trademark (United States Trademark Registration Number 2,074,795)
12 is attached hereto as **Exhibit 12**. This registration remains in full force and effect.

13 13. Mag Instrument has also developed a family of word marks
14 incorporating the letters "MAG" in connection with the sale of its flashlights and
15 related products. Since at least as early as February 22, 1979, Mag Instrument
16 adopted and began using "MAG INSTRUMENT" as its name and trademark in
17 connection with its manufacture, advertising, and sale of flashlights and related
18 products. Mag Instrument is the owner of United States Trademark Registration
19 No. 1,715,086 ("the '086 trademark") for "MAG INSTRUMENT," which is valid,
20 enforceable, and incontestable. A true and correct copy of the '086 trademark is
21 attached hereto as **Exhibit 13**.

22 14. Plaintiff Mag Instrument alleges that since at least as early as February
23 22, 1979, Mag Instrument has also been using the trademark "MAG-LITE" in
24 connection with its manufacture, advertising, and sale of flashlights and related
25 accessories/products. Mag Instrument is the owner of United States Trademark
26 Registration No. 1,154,816 ("the '816 trademark") for "MAG-LITE," which is
27 valid, enforceable, and incontestable. A true and correct copy of the '816
28 trademark is attached hereto as **Exhibit 14**.

1 15. Plaintiff Mag Instrument alleges that since at least as early as January
2 9, 1992, Mag Instrument has also been using the trademark "MAG" in connection
3 with its manufacture, advertising, and sale of flashlights and related
4 accessories/products. Mag Instrument is the owner of United States Trademark
5 Registration No. 1,975,632 ("the '632 trademark") for "MAG," which is valid,
6 enforceable, and incontestable. A true and correct copy of the '632 trademark is
7 attached hereto as **Exhibit 15**.

8 16. Plaintiff Mag Instrument alleges that since at least as early as April 15,
9 1986, Mag Instrument has also been using the trademark "MINI MAGLITE" in
10 connection with its manufacture, advertising, and sale of flashlights and related
11 accessories/products. Mag Instrument is the owner of United States Trademark
12 Registration No. 1,389,804 ("the '804 trademark") for "MINI MAGLITE," which
13 is valid, enforceable, and incontestable. A true and correct copy of the '804
14 trademark is attached hereto as **Exhibit 16**.

15 17. Plaintiff Mag Instrument alleges that since at least as early as July 12,
16 1983, Mag Instrument has also been using the trademark "MAG-NUM STAR" in
17 connection with its manufacture, advertising, and sale of flashlight bulbs. Mag
18 Instrument is the owner of United States Trademark Registration No. 1,245,187
19 ("the '187 trademark") for "MAG-NUM STAR," which is valid, enforceable, and
20 incontestable. A true and correct copy of the '187 trademark is attached hereto as
21 **Exhibit 17**.

22 18. Plaintiff Mag Instrument alleges that since at least as early as
23 September 30, 1982, Mag Instrument has also been using the trademark "MAG
24 CHARGER" in connection with its manufacture, advertising, and sale of flashlights
25 and related accessories/products. Mag Instrument is the owner of United States
26 Trademark Registration No. 2,999,097 ("the '097 trademark") for "MAG
27 CHARGER," which is valid and enforceable. A true and correct copy of the '097
28 trademark is attached hereto as **Exhibit 18**.

1 19. Plaintiff Mag Instrument alleges that since at least as early as 1989,
2 Mag Instrument has also been using the trademark "WHITE STAR" in connection
3 with its manufacture, advertising, and sale of replacement flashlight lamps. Mag
4 Instrument is the owner of United States Trademark Registration No. 2,319,027
5 ("the '027 trademark") for "WHITE STAR," which is valid, enforceable, and
6 incontestable. A true and correct copy of the '027 trademark is attached hereto as
7 **Exhibit 19.**

8 20. Plaintiff Mag Instrument alleges that since at least as early as 1984,
9 Mag Instrument has also been using the trademark "THE PROFESSIONAL
10 FLASHLIGHT" in connection with its manufacture, advertising, and sale of
11 flashlights. Mag Instrument is the owner of United States Trademark Registration
12 No. 1,709,897 ("the '897 trademark") for "THE PROFESSIONAL
13 FLASHLIGHT," which is valid, enforceable, and incontestable. A true and correct
14 copy of the '897 trademark is attached hereto as **Exhibit 19A.**

15 21. Defendant TerraLUX began marketing, distributing, advertising,
16 promoting, importing, offering for sale, and/or selling the TerraLUX Products
17 subsequent to plaintiff Mag Instrument's use and registration of the Subject Marks.

18 22. In addition to its federal trademark registrations and in furtherance of
19 its effort to develop and promote a family of marks incorporating the term "MAG,"
20 Mag Instrument also owns the following state trademark registrations: California
21 Trademark Registration No. 60,569 for "MAG-LITE," California Trademark
22 Registration No. 66,754 for "MAG-NUM STAR," California Trademark
23 Registration No. 78,422 for "MINI MAGLITE," and California Trademark
24 Registration No. 86,000 for "MINI MAGLITE AAA." True and correct copies of
25 those registrations are attached hereto as **Exhibits 20-23.** (Hereinafter, "Subject
26 Marks" refers to the state registrations and the federal registrations. "State Subject
27 Marks" refers only to the state registrations).
28

23. TerraLUX, its officers, directors, employees, and attorneys, are hereby permanently enjoined from engaging in any of the following activities, unless so authorized by Mag Instrument:

(a) manufacturing, using, marketing, distributing, advertising, promoting, importing, offering for sale, and/or selling the Minimax Flashlights;

(b) manufacturing, using, importing, offering for sale, and/or selling any flashlight that infringes the '438 patent or the '439 patent, unless found invalid or unenforceable by a court of competent jurisdiction without any right of appeal;

(c) inducing or enabling others to manufacture, use, import, offer for sale, and/or sell any flashlight that infringes the '438 patent or the '439 patent;

(d) using the Subject Marks (except to designate that a TerraLUX product is suitable for use with a trademarked Mag Instrument Product) or using MiniMax, MicroStar, MaxStar, The Professional's Choice, MaxCharger, or any other mark, design, reproduction, copy or symbol that is a colorable imitation thereof in connection with the manufacturing, use, marketing, distribution, advertisement, promotion, importation, offer for sale, and/or sale of flashlights or any goods or services not originating from or authorized by Mag Instrument; and

(e) representing that goods, services, or other products provided by TerraLUX are sponsored, approved, authorized by, or originate from Mag Instrument.

24. Service by mail upon TerraLUX, addressed to William D. Meyer, Hutchinson Black and Cook, LLC, 921 Walnut Street, Suite 200, Boulder, Colorado 80302, or any alternative recipient designated in writing by TerraLUX, of a copy of this Consent Judgment and Permanent Injunction entered by the Court is deemed sufficient notice under Federal Rule of Civil Procedure 65. It shall not be necessary for TerraLUX to sign any form of acknowledgement of service.

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1 25. The parties shall bear their own attorneys' fees and costs.

2 **IT IS SO ORDERED:**

3
4 Dated: April 17, 2008

By: Virginia A. Phillips
Hon. Virginia A. Phillips
United States District Court Judge

6
7 **APPROVED AS TO FORM AND CONTENT:**

8
9 Dated: January __, 2008

JONES DAY

10
11 By: _____
Robert C. Weiss

12 Attorneys for Plaintiff
13 MAG INSTRUMENT, INC.

14
15 Dated: January __, 2008

HUTCHINSON BLACK AND COOK, LLC

16
17 By: _____
William D. Meyer

18 Attorneys for Defendant
19 TERRALUX CORP.